

REMARKS

Claims 29-49 are pending in the application. Claims 1-28 have been canceled. Claims 29 and 37 have been amended. Applicant submits that no new matter has been added to the application by the amendment.

Rejection - 35 U.S.C. § 103

The Examiner rejected claims 29-49 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,674,541 (Kamiyama et al.) in view of U.S. Patent No. 7,145,899 (Pearce et al.). Applicant respectfully traverses the rejection.

The Examiner states that Kamiyama et al. does not disclose two separate categories of telephone numbers but since Kamiyama et al. does teach an address translation table it would be a clear extension to provide a separate table with the same functionality for any separate category of telephone numbers. The Examiner also states that Pearce discloses two separate categories of telephone numbers as his system utilizes digit analysis that distinguishes between internal telephone numbers and external telephone numbers and thus it would be a clear extension of his system to provide separate tables. The Examiner further states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kamiyama et al. by adding the ability to utilize two categories of telephone numbers as provided by Pearce et al. Applicant respectfully traverses the rejection.

Kamiyama et al. is directed to a plurality of relay apparatuses, for example 1-10 and 1-20 for transmitting facsimile data between first facsimile apparatuses 1-31, 1-32 connected to a first relay apparatus and second facsimile devices 1-41, 1-42, connected to a second relay apparatus. Each of the relay apparatuses has an address translation table which includes the single telephone number and a corresponding network address of each facsimile connected to the relay apparatus. As shown in Fig. 1, and col. 4, lines 50-53 and col. 5, lines 20-23, each facsimile has only a single telephone number and is connected to one and only one of the relay apparatus. In operation, communication between facsimiles, including all handshaking, is transmitted through an internet protocol (IP) network using transmission control protocol (TCP) via the first and second relay apparatuses.

Pearce et al. is directed to a method of routing calls through a packet switched telephone network. A communication network 10 includes a plurality of call managers 26 located in the packet network that control one or more IP telephony devices 22. The call managers 26 and the IP telephony devices 22 are interconnected via a LAN 20, WAN 30 or the Internet 40. Gateways 24 connect the LANs to the PSTN. Telephony devices connected to the PSTN include inside telephones 54 connected to the PSTN via a PBX and outside telephones 68 connected to the PSTN via a central office 62. Note that the telephony devices are directly connected to either the PSTN via a central office 62 or a PBX 50, or to a LAN/WAN and that no telephony device is connected to both a LAN/WAN and to the PSTN (Fig. 1). Further, the telephony apparatus include at most a single network address and a single telephone number (col. 4, line 66 –col. 5, line17).

The call managers 26 control call processing, routing, device configuration and other functions within the communication network 10. Each call manager 26 includes a registration information table 110 (Figs. 3 and 7) containing a list of digit strings and a list of process identification numbers (PID). The list of digit strings and corresponding PIDS in each call manager includes the telephone number of each device with which communication might be desired from the call manager (col. 7, lines 11-27). Each PID includes a node number, representing a call manager, a process name and an instance number (col. 7, lines 55-67). The PID identifies the process for communicating with the corresponding telephone number. Thus the PID allows a call manager to establish communication between devices throughout the communication network 10 (col. 8, lines 1-19).

An IP telephony device 22 may be assigned an IP address by the LAN when coming on line. The IP telephony device 22 may then register with a call manager 26 using its telephone number and its IP address. Alternatively, the telephony device 22 may request that it be assigned a telephone number and/or an IP address.

When a first device 22 wishes to establish communication with a second device 22b, the first device 22a communicates one or more digits identifying the second device with which communication is to be established to a call manager 26. The call manager associates the digit sequence with a PID, which is used to locate the node to which the second device is connected, and so on.

Each of independent claims 29, 35, 37 and 38 has been amended to make clear that each address supplying device contains the telephone numbers of a first category of telephone numbers and not a second category of telephone numbers and that the address supplying devices are separated by the network. Accordingly, Applicants submit that combining the features of Kamiyama et al. and Pearce et al., does not teach all the elements of amended claims 29, 35, 37 or 38.

Kamiyama et al. does not teach or suggest first and second address supplying devices, each of which provides a network address to an image communication apparatus as recited in amended claims 29, 35, 37 and 38. The relay devices disclosed by Kamiyama et al. perform the function of a router or gateway (col. 4, lines 39-43, col. 5, line1 to col. 6, line 19). As such, the relay devices do not provide the network address to the calling image communication apparatus but rather, handle internally the translation of the called telephone number to an IP address and the TCP protocol for transmitting the image to a called image communication apparatus.

Further, as noted by the Examiner, Kamiyama et al. does not teach or suggest two categories of telephone numbers. Consequently, Kamiyama et al. can not teach or suggest that each address supplying device contains the telephone numbers of a first category of telephone numbers and not a second category of telephone numbers. Nor does Kamiyama et al. disclose any communication devices having both a first telephone number belonging to a first category of telephone numbers, a second telephone number belonging to a second category of telephone numbers and an IP address. Further, because each communications device is connected to only a single relay, the communications devices do not include a judging section for determining which address supplying device the input telephone number is to be directed, as recited in claims 29, 35, 37 and 38.

Similarly, Pearce et al. does not teach or suggest first and second address supplying devices, each of which provides a network address to an image communication apparatus as recited in amended claims 29, 35, 37 and 38. Each call manager device 26 performs the functions of call processing, routing call transfer etc. (col. 4, lines 48-54, col. 11, line 43 to col. 15, line 14). As such, the call managers 26 do not provide the network address to the telephony devices 22 but rather, handle internally the translation of the called telephone number to an IP address and the network protocols for communicating between the telephony devices.

The Examiner argues that Pearce et al. discloses two categories of telephone numbers at col. 7, lines 36 -54 and further argues that because the two categories of telephone numbers are distinguished, it would be obvious to provide separate call manager tables 110 for the two categories of telephone numbers.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), MPEP §2143.01.

Amended claims 29, 35, 37 and 38 each recite each address supplying device contains the telephone numbers of a first category of telephone numbers and not a second category of telephone numbers and that the address supplying devices are separated by the network.

Because the claimed address supplying devices are separated by a network, if Pearce et al. were modified to provide separate manager tables for each category of telephone numbers, as proposed by the Examiner, it would also require that each telephony device disclosed in Pearce et al. be modified to direct the telephone number to the respective address supplying device. Thus, the principle of operation of the reference would be impermissibly modified.

Applicant submits that Kamiyama et al. and Pearce et al. are not properly combinable under §103. Pearce et al. does not explicitly provide the separate tables which form the basis of the Examiner's combining. Thus one of ordinary skill in the art with Pearce et al. before him could hardly be motivated to incorporate a feature from a reference into his invention which does not exist in the reference.

Further, even if Kamiyama et al. and Pearce et al. were combined in accordance with the Examiner's construction, their combination would fall short of meeting the specific structure/method of amended claims 25, 35, 37 and 38 because the combination proposed by the Examiner still would not:

1. teach or suggest first and second address supplying devices that provide a network address to an image communications apparatus;
2. teach or suggest that the first and second address supplying devices are separated by a computer network; and

3. teach or suggest a judging section in each image communications device that directs an input telephone number to one or the other of a first address supplying device and a second address supplying device.

Applicant submits that the combination of Kamiyama et al. and Pearce et al. does not make independent claims 25, 35, 37 and 38 obvious. Accordingly, for all the above reasons, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of claims 25, 35, 37 and 38.

Further, it is respectfully submitted that since claims 29, 35 and 38 have been shown to be allowable, claims 30-34, 36 and 39-49 dependent on claims 29, 35 and 38 respectively are allowable, at least by their dependency. Accordingly, for all the above reasons, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection of claims 30-34, 36 and 39-49.

Conclusion

Insofar as the Examiner's rejections have been fully addressed, the instant application, including claims 29-49, is in condition for allowance and Notice of Allowability of claims 29-49 is therefore earnestly solicited.

Respectfully submitted,

Hiroshi Endo

August 31, 2007
(Date)

By:



LOUIS SICKLES II
Registration No. 45,803
AKIN GUMP STRAUSS HAUER & FELD LLP
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103-7013
Telephone: 215-965-1200
Direct Dial: 215-965-1294
Facsimile: 215-965-1210
E-Mail: lsickles@akingump.com

LS/